

**REMARKS/DISCUSSION OF ISSUES**

Claims 1, 3, 5-14 are presently pending. All pending claims have been amended.

Claims are amended for non-statutory reasons, to place them in standard U.S. patent practice format.

***Rejections***

In response to the Office Action's objection to Claim 7, Applicants respectfully believe the amendment to Claim 7 renders the objection moot and requests its withdrawal.

On the merits, the Office Action rejected claims 1, 3, 5-7 and 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Naghian (WO 00/04649; hereinafter "Naghian") in view of Kaneda et al. (U.S. Patent No. 6,343,218; hereinafter "Kaneda"). For at least the reasons set forth below, it is respectfully submitted that these claims are allowable over the cited reference.

M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully believe that there is no motivation to combine Naghian and Kaneda, and that the Office Action fails to provide suggestion as to why one of

skill in the art at the time of the invention would have the requisite expectation of success on the merits to modify Naghian's averaging system with Kaneda's SIR average.

First, as stated in the Office Action, Naghian fails to recite or suggest measuring a time rate of change of received SIR over a predetermined period from the transmitting station. The Office Action argues that Kaneda supplies this SIR averaging. However, Naghian requires determination of optimum power levels determined based on the average of previous power control steps or a ratio of real SIR versus target SIR (See, e.g., page 6, paragraph 3). Kaneda's SIR averaging is performed by TPC bit detectors 6, 7 as "reliability information". Combining portion 8 of Kaneda combines the two output TPC bit detectors 6, 7 and then the TPC bits from a plurality of connected base stations are combined and compared with a threshold value after weighting according to the reliability information (see, e.g., Kaneda, Col. 8, lines 52-65). One of ordinary skill in the art at the time of the invention would fail to recognize that Kaneda's SIR averaging would be an effective substitute for Naghian's ratio of real SIR to target SIR because Naghian compares previous power control commands to calculate transmission power increase or reduction, whereas Kaneda's TPC bits are collected, weighted according to reliability information, and then compared with a threshold value and then transmission power control is determined. Neither reference provides a suggestion or motivation for this substitution.

Second, Naghian's method could not simply be adapted to use SIR averaging without undue experimentation and simulation that would provide evidence of a likelihood of success in doing so.

Third, Claim 1 is also believed patentable since the transmitting station is adapted to adjust its output power at a plurality of different rates, and the receiving station is adapted to determine, from measurements of a time rate of change of received signal to interference ratio averaged over a predetermined period received from the transmitting station, an optimum rate of adjustment of the output power of the transmitting station and is adapted to communicate said optimum rate of adjustment to the transmitting station (and not shown in the prior art), cannot be required without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). Applicant believes the rejection of Claim 1 over Naghian in view of Kaneda to be impermissible hindsight. Claim 1 is believed patentable over Naghian in view of Kaneda for at least this additional reason.

Claims 9 and 13 recite a secondary station and a method substantially corresponding to the radio communication system of Claim 1 and are believed patentable for at least the same reasons.

Claims 3, 5-8, 10-12, and 14 depend from one or another of the independent Claims recited above and are believed patentable for at least the same reasons. In

addition, Applicants respectfully believe Claims 3, 5-8, 10-12, and 14 to be independently patentable and request separate consideration of each claim.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

By 

Aaron Waxler,

Reg. 48,027

(914) 333-9608

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